



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/205,056	12/03/98	DATH	J F-722

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EXAMINER

YILDIRIM, B

ART UNIT

PAPER NUMBER

1764

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/205,056

Applicant(s)
Dath et al.

Examiner
Bekir L. Yildirim

Group Art Unit
1764

☒ Responsive to communication(s) filed on Jul 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 and 11-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 and 11-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. *Claims 1-9, 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Colombo et al. (EP 0109059) or Colombo et al. (EP0109060).*

Both references teach the claimed catalyst and the process steps. While the propylene yield ranges are not identical, they substantially overlap (see tables 2-4 in both references) *those in the claims.*

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colombo et al. (EP 0109059) or Colombo et al. (EP0109060).

The references teach a process for producing propylene from an olefinic feed, by contacting the feed with a high silica content catalyst, e.g. silicalite, ZSM-5, SZM-11, silicalite or the like under similar conditions with those in the instant process (see tables and claims, supra, in both).

It may be argued that the teachings in the references differ from the instant claims in that the teachings in the references do not specifically disclose the claimed propylene yield based on the olefin content of the feed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the propylene content by adjusting the reaction parameters within the broader ranges since the reference process also aims to increase the propylene production and provides general guidelines in obtaining such result since the references and the applicant have the same technical endeavor, i.e. the maximizing the propylene yield. See In re Swain et al., 32 CCPA (Patents) 1250, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; Allen et al. v. Coe, 77 App. D.C. 324, 135 F.2d 11, 57 USPQ 136. In re Antoine, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Furthermore even if it is assumed arguendo that the technical endeavors are different, i.e. the references are not concerned with maximizing propylene yield, all the process steps and the catalysts are taught in both references, thus the claimed result, i.e. the high yield, would flow naturally by the performance of the steps. "The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art

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cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)".

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

5. Applicant's arguments filed on 7/31/00 are have been fully considered but they are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The relevance of the references is self-evident.

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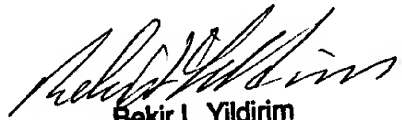
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bekir L. Yildirim whose telephone number is (703) 308-3586. The examiner can normally be reached on weekdays from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-6078.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0611.

B.L.Y.

August 14, 2000



Bekir L. Yildirim
Primary Examiner